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In re Application of :
Park, et al. :
Application No. 09/811,248 : DECISION
Filed/Deposited: 16 March, 2001 :
Attorney Docket No. 368-011B :

OFFICE OF PETITIONS

This is a decision on the petition under 37 C.F.R. §1.57(a) filed on 16 October, 2008, seeking leave to amend the specification to include inadvertently omitted portions of the specification present in the prior-filed co-pending nonprovisional application to which this application is averred to have claimed benefit (under 37 C.F.R. §1.78) on filing on 16 March, 2001.

For the reasons stated herein, the petition is **DISMISSED**.

BACKGROUND

Application papers in the above-identified application were deposited on 16 March, 2001.

Petitioner avers that the Examiner's Office action of 16 June, 2008, contended that amendments to the specification filed on 15 May, 2008, sought to introduce new matter into the application and instructed Petitioner to seek relief pursuant to 37 C.F.R. §1.57(a) before the amendment could be considered.

Further, Petitioner avers that Office records reflect the instant application is a divisional application of Application No. 08/855,499, filed on 13 May, 1997 (and which issued as Patent No. 6,271,278 (the 278 patent) on 7 August, 2001), which is a continuation in part of Application No. 08/416,269, filed on 4 April, 1995 (and which issued as Patent No. 5,750,585 (the '585 patent) on 12 May, 1998).

Petitioner sets forth the paragraphs with which he seeks to amend, and the sources of that specification as previously referenced in the prior-filed nonprovisional application(s).

APPLICABLE LAW, RULES AND MPEP

Petition under 37 C.F.R. §1.57(a)

37 C.F.R. §1.57, Incorporation by reference, states:

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under §1.55 for priority of a prior-filed foreign application, or a claim under §1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under §1.55 or §1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

On 16 October, 2008, Petitioner filed, *inter alia*, the instant petition with fee, an amendment and what is averred to be copy of the previously omitted specification, which it also is averred was present upon deposit of the parent/previously-filed a divisional application of Application No. 08/855,499, filed on 13 May, 1997 (and which issued as Patent No. 6,271,278 (the 278 patent) on 7 August, 2001), which is a continuation in part of Application No. 08/416,269, filed on 4 April, 1995 (and which issued as Patent No. 5,750,585 (the '585 patent) on 12 May, 1998), to which application Office records reflect a priority claim has been made in the instant application.

Petitioner asserts that the portions of the specification were inadvertently omitted from the instant application; points to the prior filed nonprovisional and to the claim for priority thereto made in the specification of the instant application; seeks to obtain an incorporation by reference herein under the provisions of 37 C.F.R. §1.57(a); and requests that the application be amended to include the inadvertently omitted specification on the basis that the application as filed contained a prior-benefit claim under 37 C.F.R. §1.55 or §1.78.

ANALYSIS

Petitioner has included a proper priority claim the prior filed nonprovisional a divisional application of Application No. 08/855,499, filed on 13 May, 1997 (and which issued as Patent No. 6,271,278 (the 278 patent) on 7 August, 2001), which is a continuation in part of Application No. 08/416,269, filed on 4 April, 1995 (and which issued as Patent No. 5,750,585 (the '585

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patent) on 12 May, 1998), in the specification filed with the application papers on 16 October, 2001.

Notably, however, while Petitioner evidences priority claim to the '278 patent, Petitioner does not (and apparently cannot) evidence such a claim to the '585 patent by virtue of Applicant's incorporation by reference of the contents of the nonprovisional application on filing of the present application.

Thus, a filing date of 16 October, 2001, may not be accorded the previously inadvertently omitted portions of the specification.

CONCLUSION

Thus, the petition cannot be granted because the prior-filed application (now patent) to which Petitioner seeks to claim priority was not the application identified and for which priority was claimed on deposit of the instant application.

In view thereof, the petition must be dismissed.

This application is being forwarded to the Examiner, Technology Center/AU 1796, for further processing in due course consistent with this decision.

Any questions concerning this matter may be directed to John Gillon at (571) 272-3214. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.



Anthony Knight
Supervisor
Office of Petitions